

In re Patent Application of:
Pettis, Rodney L.

Serial No. 10/760,337

REMARKS

As an initial matter, Applicants hereby confirm that during a telephone conversation with Examiner Sow-Fun Hon on November 30, 2004, in which Jeffrey Whittle, Attorney for Applicants, provisionally elected on behalf of Applicants to prosecute Claims 1-27 of the present application (see para. 1-4 of Official Action). Applicants have cancelled Claims 28-35 without prejudice, with regard to patentability, including any Doctrine of Equivalents issues.

In the Office Action, the Examiner rejected Claims 1-27 under 35 U.S.C. 103(a) as being obvious, and therefore unpatentable, over Schirmer et al., U.S. Pat. No. 5,219,666 ("Schirmer") (see para. 5-6 of Official Action). Applicant respectfully disagrees.

Claims 1-27 are Nonobvious

Applicants submit that Claims 1-27 are non-obvious and that the Examiner has not set forth a proper *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. See MPEP 2143. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. The suggestion or motivation to modify the reference and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP 706.02(J). Finally, the prior art reference must teach or suggest all claim limitations.

With respect to independent Claims 1 and 15, the Examiner states: "Schirmer provides an embodiment where [a] third outermost layer of elastomer is placed so that the second inner layer of polyolefin is positioned between the first and third outermost layers of elastomer, whereby the third outermost layer of elastomer is indirectly adhered to the second inner layer of polyolefin via a polymeric adhesive. Therefore, although Schirmer fails to teach a third outermost layer of elastomer placed so that it overlies and abuttingly contacts the second inner layer of the polyolefin, because Schirmer provides an embodiment where [the] third outermost layer of elastomer is placed so that the second inner layer of polyolefin is positioned between the first and third outermost layers of elastomer, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have directly adhered the third outermost layer of

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elastomer to the second inner layer of polyolefin so as to overly and abuttingly contact the second inner layer of polyolefin." (Paper, Page 3, No. 6, para. 2). Applicant respectfully submits, however, that the Examiner has failed to meet the first element of a *prima facie* case for obviousness. First, there is no suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. The Examiner has the burden of showing as such, and has not met it here. For example, like Claim 1, Schirmer does not describe or suggest a film having "a first outermost layer of elastomer, a second inner layer of polyolefin overlying and abuttingly contacting the first outermost layer of elastomer, and a third outermost layer of elastomer overlying and abuttingly contacting the second inner layer of the polyolefin so that the second inner layer of polyolefin is positioned between the first and the third outermost layers of elastomer." Likewise, Schirmer does not describe or suggest a film having "a first layer of a sheet of elastomer; a second layer of polyolefin having a first surface abuttingly contacting a first surface of the first layer of the sheet of elastomer; and a third layer of a sheet of elastomer abuttingly contacting a second surface of the second layer of polyolefin so that the second layer of polyolefin is positioned between the first and third layers of elastomer" as set forth in Claim 15.

Schirmer only describes two general embodiments for a multilayer film. First, Schirmer describes a "multilayer film compris[ing] a core layer comprising a very low density polyethylene; two outer layers each comprising a styrene butadiene copolymer [SBC]; and two intermediate layers each bonding the core layer to a respective outer layer, and comprising a polymeric adhesive..." (Col. 2, lines 55-62). In connection with this embodiment, Schirmer further includes Example 1 (Col. 7) and Table 2 (Col. 7 & 8), which together show twenty-three (23) different test results utilizing this described structure. All twenty-three of these test results utilize a polymeric adhesive layer positioned between the core polyethylene layer and each of the outer SBC layers. Second, Schirmer briefly describes an alternative embodiment in which "a single layer of VLDPE (polyethylene) may be adhered, either directly or by means of a polymeric adhesive layer, to a single layer of styrene butadiene copolymer..." (Col. 12, lines 26-31)(underline added). Notably, nowhere in the patent does Schirmer show, teach or suggest an embodiment in which an inner layer of polyolefin is positioned between, and abuttingly contacts, first and third outermost layers of elastomer.

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Schirmer, in fact, teaches away from the second embodiment being modified to form such a structure. Specifically, the Schirmer film is a "thin" polymeric film. (Col. 1, lines 11-13). Schirmer states that the film "exhibits excellent elasticity." (Col. 1, lines 57-58). Also, Schirmer indicates that during testing, it was discovered that as the thickness of the outermost SBC layers in the experimental structure was downgauged (that is, decreased), the final film exhibited better elasticity. (Col. 9, lines 42-45). Thus, it would be counterintuitive to one skilled in the art to add an additional SBC layer to the embodiment comprising a single layer of polyethylene and a single layer of styrene butadiene copolymer, as this would increase the total thickness of the SBC layering of the structure, which test results from the reference indicate would diminish the elasticity of the film, as well as increase the overall total thickness of the entire structure, which could adversely affect the gloss, clarity and other optical properties of the film. Not only is there no suggestion in the reference as to the desirability of modifying the reference, the modification would, in fact, not be desirable, as it would diminish the advantageous properties of the film.

The Examiner has also failed to meet the second element of a *prima facie* case for obviousness because there must be, and there is not in this present case, a reasonable expectation of success. From the discussion above, one skilled in the art would realize that modifying the reference would increase the thickness of the SBC layer and the overall thickness of the film, which would result in, among other disadvantageous features, reduced elasticity, and thus produce an inferior product.

Finally, Applicants respectfully submit that the Examiner has failed to meet the third element of a *prima facie* case for obviousness which requires all claim limitations be taught or suggested. As described previously herein, the reference does not describe or suggest, at least, a film having "a first outermost layer of elastomer, a second inner layer of polyolefin overlying and abuttingly contacting the first outermost layer of elastomer, and a third outermost layer of elastomer overlying and abuttingly contacting the second inner layer of the polyolefin so that the second inner layer of polyolefin is positioned between the first and the third outermost layers of elastomer." Likewise, Schirmer does not describe or suggest, at least, a film having "a first layer of a sheet of elastomer; a second layer of polyolefin having a first surface abuttingly contacting a first surface of the first layer of the sheet of elastomer; and a third layer of a sheet of elastomer

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abuttingly contacting a second surface of the second layer of polyolefin so that the second layer of polyolefin is positioned between the first and third layers of elastomer."

Therefore, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness because, as a minimum, Examiner has not shown: (i) some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; (ii) a reasonable expectation of success; or (iii) a teaching or suggestion of all claim limitations.

Accordingly, Claims 1 and 15 have been shown to be novel, nonobvious, and allowable with respect to the cited art. Correspondingly, dependent Claims 2-14, and 16-27 have likewise been shown to be allowable.

Applicants also submit that dependent Claims 2-14 and 16-27 also have independent novelty and are nonobvious. For example, the Examiner objected to each of Claims 7, 9, 11, 12, 14, 22, 23, 24, 26 and 27 based upon the subject matter being "inherent" in the teaching of Schirmer. Further, Claims 9, 11, 12, 14, 22, 23, 24, 26 and 27 were objected to because, according to the Examiner, the subject matter of the claims could be produced by one skilled in the art by optimizing the processing conditions of the packaging film of Schirmer. Applicant respectfully disagrees with these objections.

Each of Applicant's claims mentioned in the previous paragraph deals with a specific numerical limitation or range relating to a feature of Applicant's invention. These particular features are not discussed or described in, or suggested by, Schirmer. In particular, Schirmer does not show or suggest: "a haze in a range of about 1 % to about 10%" (Claims 7, 22); a 45° gloss in a range of about 70% to about 110% (Claims 9, 22, 27); a tensile modulus in a range of about 50,000 psi to about 120,000 psi (Claims 11, 23); a tensile strength in a range of about 2000 psi to about 3500 psi (Claims 12,24); or a dart impact strength in a range of about 300 grams to about 1000 grams (Claims 14, 26).

The Examiner asserts that these features are inherent in the reference or can be produced via optimization. The fact, however, that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what

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was necessarily present in the prior art); MPEP 1212 (IV). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP 1212 (IV). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 1212 (IV).

Schirmer only makes broad and general representations regarding certain of the advantageous features of its film, such as the film "exhibits excellent elasticity, toughness, stretch and optical properties..." (Col. 1, lines 55-60); the film has "excellent optical properties, specifically excellent gloss and clarity ..." (Col. 2, lines 47-50); and the film is "ultra-clear and glossy..." (Col. 8, line 2). The specific numerical values claimed in the present invention are new and surprising results based upon the novel and nonobvious multilayer structure that does not utilize intermediate adhesive layers, and cannot be presumed to be inherent in the nonspecific teachings and representations of Schirmer. Without any teaching or suggestion in Schirmer as to how to achieve these optimal values, Applicants' claimed results are only probable or possible according to the teachings of Schirmer. This is particularly true when the differences in the layer structures of Schirmer and Applicants' claimed invention are taken into account. As a result, Applicants submit that the features of Claims 7, 9, 11, 12, 14, 22, 23, 24, 26 and 27 are not inherent in Schirmer.

Also, Claims 6 and 21 were objected to by the Examiner because Schirmer's values allegedly fall within Applicants' claimed ranges, based on the Examiner's calculations. (Paper, p. 4, paragraph 3). Examiner has based its calculations on the assumption that if the adhesive layers were removed, to maintain the desired characteristics of the film, each of the outer SBC layers would remain the same size, and the size of the middle polyethylene layer would increase. There is no teaching or suggestion, however, that this would occur. Thus, it is also possible that if the adhesive layers were removed, for example, the middle polyethylene layer would remain

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the same size (42%), and the two outer layers would increase in size ($58\% / 2 = 29\%$ each). This possibility would bring the sizes of the layers outside of Applicants' claimed ranges. As there is no teaching or suggestion in Schirmer that one or the other of these modifications options is preferred, the Examiner should not be allowed to use improper and piecemeal-type hindsight reconstruction to determine that one skilled in the art would choose one possible option over the other. Thus, it is respectfully submitted that the Examiner's objection to Claims 6 and 21 is improper.

Therefore, Applicants respectfully submit that based on the foregoing remarks, Claim 1-27 are novel, nonobvious and patentable in view of Schirmer.

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CONCLUSION

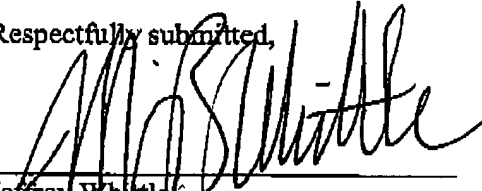
In view of the amendments and remarks set forth herein, Applicant respectfully submits that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

Date: _____

6/20/05

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Respectfully submitted,



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